

Attorney Docket No.: 145934.00004

Patent Application No.: 09/820,661

REMARKS

In the Office Action Claim 12 is objected to because of Claim dependency informality i.e., Claim 12 depending from Claim 17. The dependency of Claim 12 is now from Claim 11. The Specification is objected to for the lack of line numbers in the left margin of each page. All future correspondence between the Applicant and the Patent Office will contain appropriate line numbers.

In the Office action Claims 1 to 45 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as Claiming the same invention of co-pending patent application serial numbers – 09/820,660, 09/820,659, 09/820,613, 09/820,662. The Applicant respectfully requests this provisional rejection be held in abeyance until Allowance of this patent application.

Claim 2 stands rejected under 35 U. S. C. 112, second paragraph, as being indefinite, i.e., the use of the phrase “can be”. Claim 2 has been amended to obviate this rejection.

Claims 1 to 45 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,940,821 issued to Wical in view of U.S. Patent Number 6,363,376 issued to Van Huben. Independent Claims 1, 13, 25 and 37 have been amended. Since the independent Claims have been amended and are now allowable, it follows that all respective amended and original depending Claims are also allowable.

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The Claims stand rejected under 35 USC 103(a) as being unpatentable over U.S. Patent Number 5,940,821 issued to Wical in view of U.S. Patent Number 5,940,821 issued to Van Huben. The Claims have been amended to positively state the searching an information directory involving an index based search engine. The index based search engine recited in the Claims and delineated in the specification is not shown or disclosed anywhere in either the Wical or Van Huben patents.

The Applicant respectfully reminds the Examiner that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the cited references themselves or in knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations.

The teachings or suggestions to make the claimed combination and the reasonable expectation of success must be found in the prior art not based on the Applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 706.02 (j).

The references of record simply do not teach, suggest or disclose the presently claimed invention, either individually or in combination. It is respectfully submitted that the Examiner has not established a case of *prima facie* obviousness and is using hindsight contrary to the mandate of the Court of Appeals for the Federal Circuit in making a § 103 rejection. The Courts have held in all determinations under 35 USC § 103 that the decision maker must bring judgment to bear. It is *impermissible*, however, to engage in a hindsight reconstruction of the claimed

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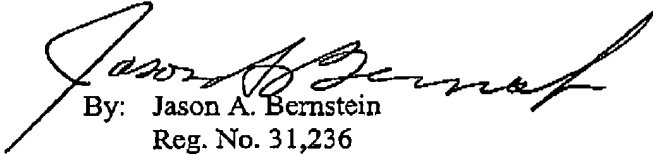
invention using the Applicant's methodology as a template and selecting steps from references to fill the gaps.

Most recently the Court of Appeals for the Federal Circuit (CAFC) has ruled that a critical suggestion to modify the prior art to arrive at a claim must be supported by some evidence in the prior art references *In re Dembicazak*, 175 F.3d 994, 50 USPQ 2d 1614 (Fed. Cir. 1999). This ruling by the CAFC is not new; the Courts have consistently ruled an explicit teaching must be delineated in the prior art references.

In this instance, the references relied upon by the Examiner taken individually or collectively, without the benefit of hindsight vision afforded by the Applicant's disclosure, do not disclose or suggest the Claimed invention.

In view of the foregoing Amendment to the Claims and associated remarks, Applicant respectfully requests the Examiner pass this case to issue. If, in the opinion of the Examiner, a telephone conference would expedite the issuance of this application, the Examiner is invited to call the undersigned Attorney.

Respectfully submitted,
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